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10/822,509	04/12/2004	Parmeshwar Gobin	COS97104C1	3054

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EXAMINER
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3687	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>27 February 2009</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>21-39</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>21-39</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some *   c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____.

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date <u>4/28/08 -- 8/13/07 - 12/5/06 - 8/15/05 - 5/4/05 --</u>
<u>10/21/04 -- 6/25/04</u>.

4)☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

Election/Restrictions

1.   Applicants' election with traverse of Group I, **claims 21-39** in the reply filed on

02.27.2009 is acknowledged. The traversal is on the ground(s) that a search and

examination of the entire application would not place a serious burden on the Examiner.

This is not found persuasive because invention Group I, has separate utility such as

administering revenue from complex subscriber groups. Invention Group II has separate

utility such as for providing offers to consumers using billing statements.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

<u>Claim 26</u> are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter because the key limitations in the claim, for

example: "generating a response message containing the invoice document based on

the retrieved invoice data; and forwarding the response message to the host for display

for the invoice document via a downloadable program", are not tied to an apparatus or a

machine.

Examiner suggests including some type of machine or apparatus in the key

limitations.

Here, the state of the law with respect to statutory subject matter eligibility under §101 is evolving and is presently an issue in several cases under appeal at the Federal Circuit with regard to process claims. As presently understood, based on Supreme Court precedent and recent Federal Circuit decisions, [see Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)] a §101 statutory process must (1) be tied to another statutory class (e.g. such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met, a method is not a patent eligible process under §101 and should be rejected as being directed to non-statutory subject matter.

For example, a method claim that recites purely mental steps (e.g. can be performed by mental process or human intelligence alone) would not qualify as a statutory process. To qualify as a §101 statutory process, the claim should (1) positively recite another statutory class (e.g. thing or product) to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps) or (2) positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state).

3.   **Claim 27-35** are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter, based on their dependency on claim 26.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b),
> by another filed in the United States before the invention by the applicant for patent or (2) a
> patent granted on an application for patent by another filed in the United States before the
> invention by the applicant for patent, except that an international application filed under the treaty
> defined in section 351(a) shall have the effects for purposes of this subsection of an application
> filed in the United States only if the international application designated the United States and
> was published under Article 21(2) of such treaty in the English language.

5.   **Claims 21-39** are rejected under 35 U.S.C. 102(e) as being anticipated by Barry

et al. [US 6,615,258].

        As per claims 21, 26, 31, and 36, Barry discloses a plurality of interfaces

configured to communicate with a plurality of billing systems to retrieve invoice data [as

illustrated in figure 25, which is a data flow diagram for various *transactions*

communicated in the system].

        - a conversion module configured to compress the invoice data for storage in a

database and to create key information for retrieving the compressed invoice data within

the database [see at least column 46: lines 8-15 (e.g. *When data is available from*

these billing systems, the online invoicing server typically performs a conversion

process and stores the converted data on tape until an audit approval)];

        - an invoice processing module configured to receive a request message from a

host for an invoice document [see at least column 46: lines 30-45 (e.g. *The client*

component of the online invoicing includes a client interface for the user to select

what data to retrieve. The data is then retrieved through various application

processing, and a list of invoices and reports are provided for the user to choose

from for online viewing)], to access the database for retrieval of invoice data

corresponding to the invoice document in response to the request message [as

illustrated in figure 7 (e.g. *a process running in a OE client application process 154*

sends transaction request messages via the infrastructure)];

    - generate a response message containing the invoice document based on the

retrieved invoice data [see at least paragraph bridging columns 19 and 20 (e.g. *Another*

object may be invoked to format the data into a response message and return the

"get application list" request message is initiated at the client application)], the

response message being forward to the host for display of the invoice document via a

downloadable program [as illustrated in figure 5 and via *step 1362 to display an online*

invoice screen at the customer workstation)];

    - forwarding the response message to the host for display of the invoice

document via a downloadable program [see at least column 8: lines 39-55 (e.g. *As*

illustrated in FIG. 2, after one of the DMZ Web servers 24 decrypts and verifies the

user session, it forwards the message through a firewall 25b over a TCP/IP

connection 23 to the dispatch server 26 on a new TCP socket while the original

socket 22 from the browser is blocking, waiting for a response)].

    <u>As per claim 22-25, 27-30, and 30-35</u>, Barry discloses wherein the host

receives the response message via a web browser, the downloadable program being

executed within the web browser [see at least column 6: lines 34-39 (e.g. *report*

applications using a Web browser paradigm)];

- wherein the downloadable program is platform independent with respect to the

host [see at least column 2: lines 47-55 (e.g. *The popularity of the public Internet*

provides a measure of platform independence for the customer, as the customer

can run their own Internet Web-browser and utilize their own platform connection

to the Internet to enable service)];

- wherein the host supports selecting figures presented in the invoice document

for performing an arithmetic operation on the selected figures [with reference to figure

56, *the online invoicing server 1350 stores documents from various billing*

systems and performs the various database queries and function calls in

response to requests received from the customer via the online invoicing proxy

1340. Particularly, the online invoicing server 1350 is responsible for tasks

including data collection, calculation, storage, and report generation)];

- wherein the host populates a products and date range field associated with a

user identifier [see at least column 15: lines 36-42 (e.g. *All access to the suite of*

applications is controlled by user identifiers (userids) and passwords)], the

products and date range field listing application services and time periods for which the

invoice document is available for presentation [as illustrated in figure 22, *a flow*

diagram illustrating an online invoicing back-end server process flow when

responding to client requests for document presentation)];

- wherein the host receives the response message via a web browser, the downloadable program being executed within the web browser [as illustrated in figure 1, *a diagrammatic illustration of the software architecture component in which the present invention functions. A first or client tier 10 of software services are resident on a customer workstation 10 and provides customer access to the enterprise system, having one or more downloadable application objects directed to front-end business logic, one or more backplane service objects for managing sessions, one or more presentation services objects for the presentation of customer options and customer requested data in a browser recognizable format and a customer supplied browser for presentation of customer options and data to the customer and for communications over the public Internet)*];

- wherein the downloadable program is platform independent with respect to the host [see at least column 7: lines 14-20 (e.g. *The customer workstation includes client software capable of providing a platform-independent, browser-based, consistent user interface implementing objects programmed to provide a reusable and common GUI abstraction and problem-domain abstractions)*)].

As per claims 37-39, Barry discloses: receiving the response message over a secure communication session of a packet switched [as reference in figure 2, *it is understood that each Intranet server of suite 30 communicates with one or several consolidated databases which include each customer's data management information. For example, the Services Inquiry server 36 includes communication with the enterprise's Customer Service Management legacy platform 40(a). Such*

network management and customer network data is additionally accessible by

authorized management personnel. As shown in FIG. 2, other legacy platforms,

e.g. 40(d), may also communicate individually with the Intranet servers for

servicing specific transactions initiated at the client browser. The illustrated

legacy platforms 40(a))];

- wherein the downloadable program is platform independent [see at least

column 7: lines 14-20 (e.g. *The customer workstation includes client software*

capable of providing a platform-independent, browser-based, consistent user

interface implementing objects programmed to provide a reusable and common

GUI abstraction and problem-domain abstractions)];

- highlighting figures on the image of the invoice document; and performing an

arithmetic operation of the highlighted figures [with reference to figure 56, *the online*

invoicing server 1350 stores documents from various billing systems and

performs the various database queries and function calls in response to requests

received from the customer via the online invoicing proxy 1340. Particularly, the

online invoicing server 1350 is responsible for tasks including data collection,

calculation, storage, and report generation)].

<u>**Examiner's Note:**</u> The Examiner has cited particular paragraph (s) or column

(s) or line number (s) in the reference (s) as applied to the claims for the convenience of

the applicant (s). Although the specified citations are representative of the teachings in

the art and are applied to the specific limitations within the individual claim, other

passages and figures may apply as well. It is respectfully requested from the applicant

(s), in preparing the responses, to fully consider the reference (s) in entirety as

potentially teaching all or part of the claimed invention, as well as the context of the

passage as taught by the prior art or disclosed by the Examiner.

Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. The PTO 1449 forms have been reviewed and considered.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to GARCIA ADE whose telephone number is (571)272-

5586. The examiner can normally be reached on M-F 8:30AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Matthew S. Gart can be reached on 571.272.3955. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew S Gart/   Garcia Ade
Supervisory Patent Examiner, Art Unit 3687   Examiner
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